

REMARKS/ARGUMENTS

In the Office Action mailed February 9, 2009 (hereinafter, "Office Action"), claims 1-24 stand rejected under 35 U.S.C. § 103. Claims 1, 9 and 17 are being amended.

Applicant respectfully responds to the Office Action.

I. Claims 1-3, 9-11 and 17-19 Rejected Under 35 U.S.C. § 103(a)

Claims 1-3, 9-11 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,213,060 to Kemp et al. (hereinafter, "Kemp") in view of U.S. Patent No. 6,032,162 to Burke (hereinafter, "Burke"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

Claim 1 as amended recites "determining a network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device." Support for this amendment may be found in Applicant's Specification on at least page 1, line 22 – page 2, line 18. Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter.

Kemp states:

The present invention concerns creation of printer instances in a printers folder on a workstation. More particularly, the present invention concerns creating a printer instance in the printers folder of a workstation for peer-to-peer communication over a local network between the workstation and the printer by accessing a website listing of printers that can be added to the

printers folder of the workstation and selecting a printer from the website listing, whereby in response to the selection, identification information of the selected printer and command information is transmitted via the Internet to the workstation such that printer configuration information and print driver information of the printer are automatically obtained and installed on the workstation and the instance of the printer is created in the printers folder.

Kemp, col. 1, lines 10-24.

The context of Kemp is different from that contemplated in claim 1. Kemp is directed towards creating “printer instances in a printers folder on a workstation.” Specifically, Kemp describes how “printer configuration information and print driver information of the printer are automatically obtained and installed on the workstation.” “Creating a printer instance in the printers folder of a workstation” is not “determining the network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device.” Furthermore, Kemp does not teach or suggest any actions to be performed “in response to the creation of a print job.” Kemp states that “the user is able to install the printer on their workstation and submit print jobs to the printer.” (Kemp, col. 2, lines 20-21). Because a user submitting print jobs to the printer would expect the printer drivers to already be installed on the workstation, the steps performed in Kemp are performed prior to the “creation of a print job.” Thus, Kemp does not teach or suggest “determining the network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device.”

The addition of Burke does not overcome the deficiencies of Kemp. Burke is related to the “field of digital signal processing, and in particular to the processing, storage and activation of Internet address links.” (Burke, col. 1, lines 5-7). Burke does not teach or suggest steps “in response to the creation of a print job” nor does Burke teach or suggest anything to do with print jobs. Thus, Burke does not teach or suggest “determining the network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device.”

Claim 1 as amended further recites “wherein the peripheral device has a network address that is not known to the client device, wherein the client device is unable to use an existing Application Program Interface (API) call to obtain the network address of the peripheral device.” Support for

this amendment can be found in Applicant's Specification on at least Page 4, line 20 – page 5, line 9 and page 9, line 18 – page 10, line 2. Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter.

Kemp describes how “printer configuration information and print driver information of the printer are automatically obtained and installed on the workstation and the instance of the printer is created in the printers folder.” (Kemp, col. 1, lines 21-24). A printer instance is created “in the printers folder of a workstation for peer-to-peer communication over a local network between the workstation and the printer by accessing a website listing of printers that can be added to the printers folder of the workstation.” (Kemp, col. 1, lines 13-16). Kemp further states that “when a new printer is installed on the network, the network administrator generally adds the printer to a listing of printers maintained on a web-server.” (Kemp, col. 6, lines 41-43).

Kemp thus describes a “network administrator” adding the printer to a “listing of printers maintained on a web-server.” The above cited portions of Kemp do not teach or suggest “wherein the peripheral device has a network address that is not known to the client device, wherein the client device is unable to use an existing Application Program Interface (API) call to obtain the network address of the peripheral device.” In fact, Kemp does not teach or suggest the use or nonuse of APIs for obtaining network addresses. Thus, Kemp does not teach or suggest “wherein the peripheral device has a network address that is not known to the client device, wherein the client device is unable to use an existing Application Program Interface (API) call to obtain the network address of the peripheral device.”

The addition of Burke does not overcome the deficiencies of Kemp. Although Burke describes the “processing, storage and activation of Internet address links,” (Burke, col. 1, lines 6-7), Burke does not teach or suggest the use or nonuse of APIs for obtaining network addresses. Thus, Burke does not teach or suggest “wherein the peripheral device has a network address that is not known to the client device, wherein the client device is unable to use an existing Application Program Interface (API) call to obtain the network address of the peripheral device.”

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from the cited references. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Kemp, alone or in combination with Burke, does not teach or suggest all of the subject matter of claim 1.

Claims 2 and 3 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 3 be withdrawn.

Claim 9 is being amended to recite “determine a network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device, wherein the peripheral device has a network address that is not known to the client device, wherein the client device is unable to use an existing Application Program Interface (API) call to obtain the network address of the peripheral device.” As discussed above, Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 9 is allowable. Claims 10 and 11 depend either directly or indirectly from claim 9, and are therefore allowable for at least the same reasons.

Claim 17 is being amended to recite “means for determining a network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device, wherein the peripheral device has a network address that is not known to the client device, wherein the client device is unable to use an existing Application Program Interface (API) call to obtain the network address of the peripheral device.” As discussed above, Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 17 is allowable. Claims 18 and 19 depend either directly or indirectly from claim 17, and are therefore allowable for at least the same reasons.

II. Claims 4-8, 12-16 and 18-24 Rejected Under 35 U.S.C. § 103(a)

Claims 4-8, 12-16 and 18-24 stand rejected under 35 U.S.C. § 103(a) as being unpatenable over Kemp in view of Burke in further view of U.S. Patent Application Publication No. 2002/0059489 to Davis et al. (hereinafter, “Davis”). This rejection is respectfully traversed.

The standard to establish a *prima facie* case of obviousness is provided above.

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

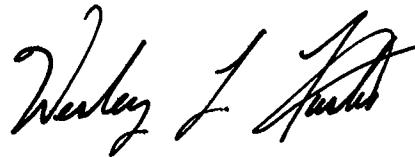
Claims 4-8 depend either directly or indirectly from claim 1. Claims 12-16 depend either directly or indirectly from claim 9. Claims 18-24 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 4-8, 12-16 and 18-24 be withdrawn for the reasons above.

Appl. No. 10/676,272
Amdt. dated May 11, 2009
Reply to Office Action of February 9, 2009

III. Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being the most prominent.

/Wesley L. Austin/

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